REMARKS

The Examiner indicated in the Office Action Summary that claims 1-14 and 19-38 are pending. Applicant mistakenly omitted claims 15-18 in the preliminary amendment filed on or about July 14, 2004. Applicant never intended to cancel these claims. Applicant intended that these claims remain pending in the application. To ensure these claims, claims 15-18 of U.S. Patent No. 6,272,700, get examined, Applicant has added them as new claims 39-42.

Claims 8-12 were allowed.

Claims 1-3, 5-7, 14, 19-26, 28-31 and 33-38 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,577,841 issued to Hagemeister in view of U.S. Patent No. 198,546 issued to Lombart. Applicant respectfully traverses the rejection for the following reasons.

First, claims 1-14 and 39-42 are identical to the claims of Applicant's U.S. Patent No. 6,272,700. The Lombart reference was cited in Applicant's U.S. Patent No. 6,272,700. The Hagemeister reference was presumably available for the Examiner to cite, but the Examiner failed to do so, presumably because the Examiner did not think it relevant enough to cite.

Second, the Examiner has not established a prima facie case of obviousness. The Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument. Id. If examination at the initial stage does not produce a prima facie case of obviousness, then without more, the applicant is entitled to grant of the patent. Id. A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a

person of ordinary skill in the art. In re Bell, 991 F.2d 781, 782, 26 USPQ.2d 1529, 1531 (Fed. Cir. 1993).

In other words, to properly combine references to make a prima facie case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the two references. See e.g. ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984); W. L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311 (Fed. Cir. 1983); and In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999).

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Hagemeister box spring to add a plurality of intermediate slats spaced above the intermediate rails. The Hagemeister box spring has no intermediate slats spaced above the base nor any teaching or suggestion to put them in. As stated in the Background of the Invention Section of the Hagemeister patent, the purpose of the Hagemeister product is to incorporate coil springs and bent wire or modular springs into the same box spring. Without a teaching, suggestion or inference in the Hagemeister patent of adding intermediate slats, the combination of references used the Examiner is improper.

The combination of Hagemeister and Lombart references is further improper because the Examiner has simply used applicant's claims as a blueprint to abstract bits and pieces of the prior art together, through hindsight to make the above § 103 rejection. It must be recognized that a combination of prior art is improper and not "obvious" if the only suggestion or reason for combining

the teachings of the prior art is to be found in the present application. In re Pye & Peterson, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination "obvious" unless the art also contains something to suggest the desirability of the combination. In re Rinehart, 189 USPQ 143 (CCPA 1976); In re Regel, 188 USPQ 136 (CCPA 1975); In re Avery, 186 USPQ 161 (CCPA 1975); In re Imperato, 179 USPQ 730 (CCPA 1973); and In re Andre, 144 USPQ 497 (CCPA 1965).

It is submitted that the Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. W.L. Gore, 220 USPQ at 312 (Fed. Cir. 1983).

Claims 4, 13, 27 and 32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hagemeister in view of Lombart and further in view of U.S. Patent No. 4,100,631 issued to Slone. Applicant respectfully traverses the rejection for the reasons stated above.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Hagemeister box spring to add a plurality of intermediate slats spaced above the intermediate rails. Neither the Hagemeister or Lombart patent teachs, discloses or suggests using sinuous springs as spacers for such spacing. Without such a teaching, suggestion or inference in the Hagemeister patent, the combination of references used the Examiner is improper.

In view of the foregoing remarks given herein, applicant respectfully believes this case is in condition for allowance and respectfully requests allowance of the claims. If the Examiner believes any detailed language of the claims requires further discussion, the Examiner is respectfully

asked to telephone the undersigned attorney so that the matter may be promptly resolved. The Examiner's prompt attention to this matter is appreciated.

Applicant is of the opinion that additional fees of $176 are due at this time. If any charges or credits are necessary to complete this communication, please apply them to deposit account no. 23-3000.

Respectfully submitted,

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